

Remarks

The January 30, 2004 Official Action and the references cited therein have been carefully considered. In view of the amendments presented herewith and these remarks, favorable reconsideration and allowance of this application are respectfully requested.

At the outset, it is noted that a shortened statutory response period of three (3) months was set in the January 30, 2004 Official Action. The initial due date for response, therefore, was April 30, 2004. A petition for a two (2) month extension of the response period is presented with this amendment and request for reconsideration, which is being filed within the two (2) month extension of the response period.

As another preliminary matter, the January 30, 2004 Official Action indicated that the Restriction Requirement set forth in the October 30, 2002 Official Action has been maintained, notwithstanding applicant's request for reconsideration and withdrawal of same. Applicant again respectfully submits that this requirement is improper for the reasons discussed below and requests rejoinder of product claims 9-21 with process claims 1-8.

In the event that claims 1-8 are finally held withdrawn from consideration in this application, applicant reiterates that the election of the subject matter of claims 9-20 for examination in this application is without prejudice to his right to file one (1) or more continuing applications, as provided in 35 U.S.C.

§121, on the subject matter of the withdrawn claims.

In the January 30, 2004 Official Action claims 9, 15 and 16 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,500,303 to Anderson. Additionally, claims 10-14 and 17-20 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the combined disclosures of the aforementioned Anderson patent and U.S. Patent 6,379,726 to Tomasula. According to the Examiner, it would have been obvious from the combined disclosures of the cited references to (i) use the edible film of the Anderson patent on any food product including pizza and cheese or heterogeneous food components having different water content when it is desired to protect such foods from the environment which can cause unfavorable consequence in the food product; (ii) use the film as a barrier layer in a pizza product to prevent moisture migration from the topping and sauce to the crust; and (iii) coat the film with lecithin, waxes or lipid to function as lubricant so that the film can be easily released from the food product.

The 35 U.S.C. §103 rejection of claims 9-20 based on the combined disclosure of Chen et al. and Tomasula, which was set forth in the June 2, 2003 Official Action, has been withdrawn. Thus, the above-noted anticipation rejection of claims 9, 15 and 16 in view of Anderson and the obviousness rejection of claims 10-14 and 17-20 in view of Anderson and Tomasula are the only grounds set forth in the January 30, 2004 Official Action for refusing the present application.

In accordance with the present amendment, claim 9 has been amended to recite that the film-forming fluid comprises a food grade cellulosic material. Support for this amendment of claim 9 is provided in the present specification at page 6, lines 26 and 37. There is also presented herewith new claim 21, which recites that "at least the second side of said film sheet is adhered to said comestible substance". Support for new claim 21 is provided at page 5, lines 17-19 and at page 12, lines 4-7 of the present specification, where it is disclosed that the method by which the edible film sheets are made results in microscopic protuberences on one surface thereof, which impart desirable properties with regard to adherence of the film sheets to comestible substances.

Furthermore, claims 10, 12, 14 and 15 have been amended so as to be dependent from new claim 21, rather than claim 9.

For the reasons set forth below it is respectfully submitted that the Anderson patent fails to provide evidence of anticipation with respect to the subject matter of claims 9, 15 and 16, and that the combined disclosures of the Anderson patent and the Tomasula patent fail to provide evidence of obviousness with respect to the subject matter of claims 10-14 and 17-20. Thus, the 35 U.S.C. §102(b) rejection of claims 9, 15 and 16 based on the Anderson patent and the 35 U.S.C. §103(a) rejection of claims 10-14 and 17-20 based on Anderson in view of Tomasula are respectfully traversed.

**A. The Anderson Patent Fails to Anticipate the Subject Matter
of Claims 9, 15 and 16**

Rejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the allegedly anticipatory prior art reference. In re Arkley, 172 U.S.P.Q. 524 (CCPA 1972). Applying this rule of law to the present case, the 35 U.S.C. §102(b) rejection of claims 9, 15 and 16 based on the Anderson patent is improper because the subject matter of those claims is nowhere identically disclosed or described in the Anderson patent.

The Anderson patent relates to a composite packaging film which is disclosed as being effective to provide an oxygen barrier for oxygen-sensitive products, such as foods, and which comprises at least outer and inner plies of a polymeric material and a substantially anaerobic space between the plies. The composite packaging film of the Anderson patent includes basically two embodiments, as summarized at column 3, lines 32-62. One embodiment includes filling the space between the plies with a substantially anaerobic gas, e.g. nitrogen. The other embodiment involves providing at least one of the two plies with a textured surface, and drawing a vacuum on the space between the plies. The purpose of providing a textured surface on at least one of the plies is to "physically separate one film from the other", as noted at column 3, lines 43 and 44 of the Anderson patent.

Further details regarding the above-mentioned

embodiments of the Anderson patent are described, in part, with reference to Figure 1, which shows a composite film barrier composed of two plies, each of which is formed of a sheet of polymeric material. See column 4, lines 42-62.

The Anderson patent next describes an embodiment in which at least one of the plies is formed of an edible polymeric barrier material, and the other is "desirably formed of an ordinary, inedible polymeric material, as in the embodiment set forth above", i.e. the sheet of polymeric material described with reference to Figure 1 at column 4, lines 42-62. The edible barrier material specifically described in the Anderson patent is applied as a water-based solution of a film-forming agent, which may be gelatin or the like. The solution is applied directly to the product to be packaged, essentially as a coating, and the solution is dried to produce the inner ply. The coated product is then sealed with the outer ply.

The Anderson patent then describes the means for providing an anaerobic space between the two plies. These include filling the space with a supply of anaerobic gas (column 6, lines 3 and 4) or drawing a vacuum on the space rather than filling the space with an anaerobic gas (column 6, lines 25 and 26). When drawing a vacuum to provide the anaerobic space, the Anderson patent recommends the use of texturing on one or both of the plies, as previously noted. As disclosed at column 6, lines 32-36, again with reference to Figure 1, "only one of the inner surface 22 of the inner film or inner surface 32 of the

outer film may be provided with such a texturing". This texturing is more specifically described as a generally grid-shaped pattern in which "the lines of the grid should be fairly close to one another so that there will not be large, smooth panes between the lines. This will add some structural support to the plies and insure that the pressure will not collapse one ply fully against the other ply, which could substantially eliminate the anaerobic space 40 between the plies". See column 6, lines 45-52. Further in this regard, the texturing is described as "a series of elongated, substantially linear protrusions on its surface. The linear protrusions of the inner surface 22 of the inner ply and those on the inner surface 32 of the outer ply are desirably oriented generally perpendicularly to one another to essentially produce a grid of abutting projections between the films. This will help to maintain anaerobic space between the two plies 20, 30 when a vacuum is drawn on the anaerobic space 40". See column 6, lines 55-60.

By contrast to the edible film described in the Anderson patent, which is formed from a solution of film-forming agent, as noted above, applicant's claims call for an edible film sheet that is self-supporting, with one side having microscopic protuberences extending from the surface thereof and the other side having a relatively smooth surface. This unique structure for an edible film sheet is the direct result of the manner in which the film sheet is made, as recited in claim 9.

It is evident from the overall disclosure of the

Anderson patent, as discussed above, that this reference utterly fails to provide response for all of the elements recited in applicant's claim 9. Although the Anderson patent mentions an edible film, on the one hand, and a textured film having elongated protrusions on at least one surface thereof, on the other hand, there is no disclosure in the Anderson patent of "an edible film having protrusions on one of the surfaces", notwithstanding the Examiner's assertion that there is.

The edible polymeric barrier material of the Anderson patent is not a self-supporting sheet. Rather, the only specific embodiment disclosed in the Anderson patent is one in which the edible barrier material is formed from a solution of a film-forming agent, e.g. gelatin. It is noteworthy in this regard that the Anderson patent uses the term "sheet" in describing the composite film barrier illustrated in Figure 1. See column 4, lines 42-49. However, the term "sheet" does not appear in the description of the edible polymeric barrier material provided at column 5, lines 22-62. There is, however, a reference back to the polymeric sheet material of Figure 1 when describing the inedible polymeric material used in conjunction with the edible polymeric barrier material. See column 5, lines 24-27. It is reasonable to conclude, therefore, that Anderson did not contemplate providing the edible polymeric barrier material in the form of a self-supporting sheet, otherwise, it presumably would have been described as such.

Moreover, even if the Anderson patent could reasonably be interpreted as disclosing an edible film sheet having protuberences on at least one of its surfaces (which applicant vigorously disputes) such a film would not have microscopic protuberences, as called for in applicant's claims. The term "microscopic", according to its ordinary meaning, refers to something so small or fine as to be not clearly distinguishable without the use of microscope. The microscopic protuberences of applicant's edible film sheet are clearly patentably distinguishable from the textured polymeric films of the Anderson patent, in which the texturing is a "series of elongated, substantially linear protrusions", or, in other words, raised lines on the film surface. Submitted herewith, as Exhibit A, is a sample of a commercially available textured polymer film of the type referred to in the Anderson patent. This film is used in vacuum packaging of solid foods, in a manner such that the linear protrusions are parallel to the plane of the film surface and allow the continued evacuation of the container's gas phase across the evacuation seam until it is closed by heat sealing after the desired degree of evacuation is achieved. Textured polymeric films such as this are readily distinguishable from the edible film sheet of the present invention, having regard to their respective compositional and structural characteristics. The elongated protrusions on the surface of the Exhibit A sample are readily visible by the unaided eye; the microscopic protuberences on the samples of applicant's edible film sheets

are not. This is evident from a comparison of the sample of the attached Exhibit A, with the samples of applicant's edible film sheet that were submitted as part of Exhibit I (samples A₁-A₂ and B₁-B₂) in applicant's response to the immediately preceding Official Action. In view of such differences, it is not at all apparent how applicant's edible film sheets could be used to achieve the packaging objectives indicated for textured polymeric films in the Anderson patent.

New claim 21 is readily distinguishable from the composite packaging film of the Anderson patent, as it requires that the second side of the edible film sheet (which is the side having the microscopic protuberences extending from a surface thereof, according to claim 9) is adhered to said comestible substance. The textured surfaces of the polymeric film plies that constitute the composite packaging material of the Anderson patent, on the one hand, are disposed away from the comestible substance and toward the anaerobic space which is defined by the plies. This is evident from the disclosure at column 6, lines 32-36 of the Anderson patent, with reference to Figure 1, that "only one of the inner surface 22 of the inner film or inner surface 32 of the outer film may be provided with such a texturing". Thus, it is clear that the "inner surface", as used in the above-quoted passage from the Anderson patent, refers to the film surface (either 22 or 32) disposed inwardly toward the so-called "anaerobic space". Considering also the function of the texturing indicated in the Anderson patent, i.e. to

physically separate one film from the other so as to prevent one ply from fully collapsing against the other ply when a vacuum is drawn on the anaerobic space, there is no disclosure or suggestion in the Anderson patent of forming microscopic protuberences on the surface of the film sheet adhering to the comestible substance, as called for in new claim 21.

Inasmuch as the Anderson patent fails to identically disclose or describe all of the claim recitations of applicant's claims 9, 15 and 16, the §102(b) rejection of those claims based on the Anderson patent is untenable and should be withdrawn.

The Anderson patent has another deficiency which clearly disqualifies it as anticipatory prior art in this case. It has long been the rule that in order for a reference to properly anticipate a claim, the reference must have placed the claimed subject matter in the possession of the public. In re Coker, 175 U.S.P.Q. 26, 29 (CCPA 1972). In the present case, the Anderson patent plainly fails to place the applicant's edible film sheet in the possession of the public, as there is no teaching provided in the Anderson patent as to how one skilled in the art would go about producing a self-supporting, edible film sheet having microscopic protuberences on a surface thereof, as called for in applicant's claim 9. The present record is otherwise silent as to how such a material could be obtained. Thus, the Examiner's assertion that the Anderson patent discloses an edible film having protrusions on one of the surfaces thereof has no factual support on the present record. That being the

case, the anticipation rejection of claims 9, 15 and 16 based on the Anderson patent cannot be maintained. Anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product. Ex parte Standish, 10 U.S.P.Q.2nd 1454, 1457 (PTO BAI 1989).

B. The Combined Disclosures of the Anderson Patent and the Tomasula Patent Fail to Render Obvious Subject Matter of Claims 10-14 and 17-20

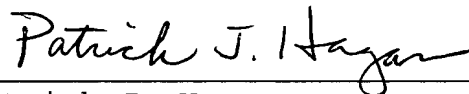
The rejection of claims 10-14 and 17-20 based on the Anderson patent in view of the Tomasula patent is untenable for at least the same reasons discussed above with respect to the impropriety of the §102 rejection of claims 9, 15 and 16 based on the Anderson patent alone. Since the Tomasula patent does not make up for the fundamental deficiencies noted above in the disclosure of the Anderson patent, the rejection of claims 10-14 and 17-20 based on the combined disclosures of the Anderson patent and the Tomasula patent is improper and should also be withdrawn.

Applicant once again requests reconsideration of the restriction requirement in this case. This requirement continues to be based on the erroneous premise that a self-supporting, edible film having one surface with microscopic protuberences and another relatively smooth surface can be made by a method other than that claimed by applicant herein. In the January 30, 2004 Official Action, the Examiner relies on the Anderson patent to support this proposition. However, for the reasons advanced

above, the Examiner's reliance on the Anderson patent in this regard is plainly misplaced. Applicant, therefore, again requests rejoinder of process claims 1-8 with product claims 9-21 for examination in this application.

In view of the amendments presented herewith and the foregoing remarks, it is respectfully urged that the objections and rejections set forth in the January 30, 2004 Official Action be withdrawn and that this application be passed to issue, and such action is earnestly solicited.

Respectfully submitted,
DANN, DORFMAN, HERRELL and SKILLMAN

A handwritten signature in cursive script, reading "Patrick J. Hagan". The signature is written in dark ink and is positioned above a horizontal line.

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PJH:cmb
Enclosure:
Exhibit A